

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andrew David Morley et al. Art Unit : 1626
Patent No. : 7,553,868 Examiner : Rebecca L. Anderson
Issue Date : June 30, 2009 Conf. No. : 8677
Serial No. : 10/542,044
Filed : July 13, 2005
Title : THIOPHENE CARBOXAMIDES AS INHIBITORS OF THE ENZYME IKK-2

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF DECISION ON
REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT
IN VIEW OF WYETH

In a Decision on Request for Recalculation of Patent Term Adjustment in View of Wyeth and Notice of Intent to Issue Certificate for Correction (“Decision”) dated April 20, 2010, the United States Patent and Trademark Office (“Office”) granted Patentee’s Request for Recalculation of Patent Term Adjustment in View of *Wyeth* (“Request for Recalculation”), which was filed February 12, 2010, for the above patent. In its Decision, the Office calculated a total PTA of 169 days.

Patentees respectfully submit that the Office did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

It is Patentees' understanding that for purposes of calculating both "A Delay" and "B Delay," the Office measured application pendency as beginning on July 15, 2005. However, as detailed below, the relevant statutes and regulations require that when calculating "B Delay" for a national stage filing under 35 U.S.C. § 371, application pendency must be measured from the date that is 30 months from the priority date of the international application (i.e., not from the date on which the application fulfilled the requirements of 35 U.S.C. § 371) unless a complete express request for early processing is filed. A complete request for early processing under 35 U.S.C. § 371(f) was filed with the present application.

The term of a patent shall, under certain circumstances, be extended if the Office fails to issue a patent within three years after the “actual filing date” of the application.

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: May 20, 2010.

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(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.

- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States ... the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

35 U.S.C. § 154(b)(1)(B). (emphasis added)

37 C.F.R. § 1.702(b) explains the meaning of the term “actual filing date” as used in 35 U.S.C. § 154(b)(1)(B). As detailed below, PTO delay for a national stage application begins if the Office fails to issue a patent within three years after the date the national stage “commenced under 35 U.S.C. 371(b) or (f).”¹

(b) *Failure to issue a patent within three years of the actual filing date of the application.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including... 37 C.F.R. § 1.702(b). (emphasis added)

35 U.S.C. §§ 371(b) and (f) refer to the time when a national stage application “commences.”

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty. 35 U.S.C. § 371(b). (emphasis added)

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with. 35 U.S.C. § 371(f).

35 U.S.C. § 371(f) relates to the situation where an applicant files an express request for early processing of an international application. In the absence of filing such a request, the U.S. national stage commences under the provisions of 35 U.S.C. § 371(b), i.e., with the expiration of

¹ Consistent with 37 C.F.R. § 1.702(b), MPEP § 2730 states that “[i]n the case of an international application, the phrase ‘actual filing date of the application in the United States’ [as used in 35 U.S.C. § 154(b)(1)(B)] means the date the national stage commenced under 35 U.S.C. 371(b) or (f).”

the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. The term “the treaty” refers to “the Patent Cooperation Treaty done at Washington, on June 19, 1970.” See 35 U.S.C. § 351(a).

“The applicable time limit” referred to in Patent Cooperation Treaty articles 22(1), 22(2), and 39(1)(a) is “the expiration of 30 months from the priority date.” As a result, “the expiration of 30 months from the priority date” is the time at which the U.S. national stage commences under the provisions of 35 U.S.C. § 371(b). This same conclusion as to the timing for commencement of the U.S. national stage is also summarized in MPEP § 1893.01.

Subject to 35 U.S.C. 371(f), commencement of the national stage occurs upon expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a). See 35 U.S.C. 371(b) and 37 CFR 1.491(a). PCT Articles 22(1), 22(2), and 39(1)(a) provide for a time limit of not later than the expiration of 30 months from the priority date. Thus, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c). MPEP § 1893.01.
(emphasis added)

In view of the foregoing, the “actual filing date” of a U.S. national stage application filed under 35 U.S.C. § 371, for purposes of calculating “B Delay” under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b), is the date that is 30 months from the priority date of the international application,² subject to the filing of an express request for early processing.

Patentees note that the Office appears to have recalculated both the “A Delay” and “B Delay” periods for a late first office action and for more than three year pendency as if no request for early processing under 35 U.S.C. § 371(f) had been filed with the present application.

² In contrast to reliance on “the expiration of 30 months from the priority date” for measuring “B Delay,” the beginning of the relevant period for purposes of calculating “A Delay” is the date on which an international application fulfills the requirements of 35 U.S.C. § 371. See 35 U.S.C. § 154(b)(1)(A)(i)(II) and 37 C.F.R. § 1.702(a)(1).

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Further, Patentees submit that this error in calculation was not present at the time of issuance; rather, both "A Delay" and "B Delay" have been recalculated anew with different amounts of PTO Delay than were present at issuance for a late first office action and for more-than-three-year pendency. Patentees submit that the time granted at issuance for a late first office action was 149 days; now, only 147 days are granted, despite the fact that a complete request for early processing under 35 U.S.C. § 371(f) was filed with the application. The Office's calculation of "B Delay" is affected by the error as well, in that the calculation currently considers three-year pendency period to commence on July 15, 2005, when in fact it should have commenced beginning on July 13, 2005, the date of filing of the complete express request for early processing of the application.

Patentees are submitting herewith the fee required by 37 C.F.R. 1.18(e). Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: May 20, 2010

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